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SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

	Application No.	Applicant(s)
Office Action Summary	10/603,835	IKENO, ATSUSHI
	Examiner	Art Unit	
	David Faber	2178	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *11 January 2007*.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims.

4)☒ Claim(s) *1-4,6-13,15-17 and 19-21* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-4,6-13,15-17 and 19-21* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

1.   This office action is in response to the Request for Continued Examination filed

on 11 January 2007.

2.   Claims 1, and 12 have been amended.

3.   Claims 1-4, 6-13, 15-17, and 19-21 are pending. Claims 1, 12, and 19-21 are

independent claims.

Drawings

4.   The drawings were received on 11 November 2006. These drawings are not

accepted.

5.   In addition to Replacement Sheets containing the corrected drawing figure(s),

applicant is required to submit a marked-up copy of each Replacement Sheet including

annotations indicating the changes made to the previous version. The marked-up copy

must be clearly labeled as "Annotated Sheets" and must be presented in the

amendment or remarks section that explains the change(s) to the drawings. See 37

CFR 1.121(d)(1). Failure to timely submit the proposed drawing and marked-up copy

will result in the abandonment of the application.

Claim Rejections - 35 USC § 112

6.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly
> claiming the subject matter which the applicant regards as his invention.

7.   Claim 1-4, 6-13, 15-18, 19-21 are rejected under 35 U.S.C. 112, second

paragraph, as being indefinite for failing to particularly point out and distinctly claim the

subject matter which applicant regards as the invention.

8.   Claims 1, 12, and 20-21 recite the use of the terminology of "can" within the claim

limitation. The use of the terminology "can" incorporates the claim to be vague and

indefinite since the scope defined is indefinite.

9.   Claims 1, and 12 recite the limitation "the respective partial documents". There is

insufficient antecedent basis for this limitation in the claim.

10.   Claim 4 recites the limitation confining the element "a division pattern" in line 2.

Examiner is unsure if is a new element or depending on "one or more division patterns"

introduced in line 5 of claim 1. Thus, there is insufficient antecedent basis for this

limitation in the claim.

Claim Rejections - 35 USC § 101

11.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of
> matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the
> conditions and requirements of this title.

12.   Claims 1-4, 6-11, and 19-20 are rejected under 35 U.S.C. 101 because the

claimed invention is directed to non-statutory subject matter.

For your reference, below is a section from MPEP 2105 :

(a) Functional Descriptive Material: "Data Structures" Representing Descriptive Material
Per Se or Computer Programs Representing Computer Listings Per Se
Data structures not claimed as embodied in computer-readable media are descriptive
material per se and are not statutory because they are not capable of causing functional

change in the computer. See, e.g., Warmerdam, 33 F.3d at 1361, 31 USPQ2d at 1760
(claim to a data structure per se held nonstatutory). Such claimed data structures do not
define any structural and functional interrelationships between the data structure and other
claimed aspects of the invention which permit the data structure's functionality to be
realized. In contrast, a claimed computer-readable medium encoded with a data
structure defines structural and functional interrelationships between the data structure
and the computer software and hardware components which permit the data structure's
functionality to be realized, and is thus statutory.

Similarly, computer programs claimed as computer listings per se, i.e., the descriptions or
expressions of the programs, are not physical "things." They are neither computer
components nor statutory processes, as they are not "acts" being performed. Such
claimed computer programs do not define any structural and functional interrelationships
between the computer program and other claimed elements of a computer which permit
the computer program's functionality to be realized. In contrast, a claimed computer-
readable medium encoded with a computer program is a computer element which defines
structural and functional interrelationships between the computer program and the rest of the
computer which permit the computer program's functionality to be realized, and is thus statutory.
Accordingly, it is important to distinguish claims that define descriptive material per se from claims
that define statutory inventions.

Computer programs are often recited as part of a claim. Office personnel should
determine whether the computer program is being claimed as part of an otherwise
statutory manufacture or machine. In such a case, the claim remains statutory irrespective of the
fact that a computer program is included in the claim. The same result occurs when a computer
program is used in a computerized process where the computer executes the instructions set
forth in the computer program. Only when the claimed invention taken as a whole is directed to a
mere program listing, i.e., to only its description or expression, is it descriptive material per se and
hence nonstatutory.

**Since a computer program is merely a set of instructions capable of being executed by a
computer, the computer program itself is not a process and Office personnel should treat
a claim for a computer program, without the computer-readable medium needed to realize
the computer program's functionality, as nonstatutory functional descriptive material.
When a computer program is claimed in a process where the computer is executing the
computer program's instructions, Office personnel should treat the claim as a process
claim. See paragraph IV.B.2(b), below. When a computer program is recited in
conjunction with a physical structure, such as a computer memory, Office personnel
should treat the claim as a product claim.**

13.   Claims 1-4, 6-11, and 20 are rejected under 35 U.S.C. 101 because the claimed

invention is directed to non-statutory subject matter. The claims appear to be claiming

"software systems" i.e. systems without hardware indication, which is a computer

program per se. Since the claims disclose computer program per se that is not

embodied on a computer readable medium, they appear non-statutory.

14.   Claim 19 remains rejected under 35 U.S.C. 101 because the claimed invention is

directed to non-statutory subject matter. Claim 19 discloses an information partitioning

program, described with a code executed by a computer, is considered as a computer

program. A computer program not embodied on a tangible computer readable medium

is not statutory

Claim Rejections - 35 USC § 102

15.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

16.   Claims 1-2, 4, 6, 8, 10, 12-13, 16, and 19 remain rejected under 35 U.S.C. 102(b)

as being anticipated by Yanase et al (US PGPub 2001/0025288, published 10/27/2001).

As per independent Claim 1, Yanase et al discloses:

- division pattern storing means for storing therein one or plural division

  patterns defining a predetermined character string which can be represented

  in a division line; document dividing means for applying the one or plural

  division patterns stored in the division pattern storing means to the inputted

  electronic document to divide the electronic document to plural partial

  documents. (FIG 7-8; Paragraph 0080, 0084: Discloses news information in

  an electronic mail format containing line separators composed of characters,

  regarded as a separator for separating articles from one another within.

  These character lines are predetermined rules for separating. (Paragraph

0079-0080) Paragraph 0084 discloses an example using FIG 7 containing

multiple character lines where the lines are used to separate the articles from

each other. In addition, other division patterns are used to separate the title

and the main body of text from within each of the separated articles. FIG. 8

shows the result of the method disclosure in Paragraph 0084.)

- labeling pattern storing means for storing therein plural labeling patterns

  provided with classification information pieces said classification information

  pieces defining a predetermined character string which specifics classification

  of a respective partial document; and labeling means for applying the labeling

  patterns stored in the labeling pattern storing means to the respective partial

  documents obtained by the division conducted by the document dividing

  means, respectively, to provide the classification information pieces. (FIG 7-8;

  Paragraph 0080, 0084: Discloses an embodiment of the process of a

  document format analysis that separates articles from each by character

  lines. These character lines are predetermined rules for separating articles.

  (Paragraphs 0079-0080) In addition, other predetermined rules determine,

  separate, and label the title of the article, text of the article and other

  information into a data structure. (Paragraphs 0079-0083, 0087) As stated in

  Paragraph 0084, predetermined character strings such as space lines specify

  a partial aspect of the document if it's a title or text of that article. For

  example, a section separated from an subsequent section with only one line

(one predetermined character string) is regarded as the title of the article and

a section separated from a subsequent section with a plurality of lines

(another predetermined character string) is regarded as the text of the article.

Thus, FIG 8 shows the result of labeling the title and text of the article based

on the classification of the predetermined character strings in the document.

FIG 10 discloses other information retained, labeling the information retained

from the document format analysis, and stored in a data structure shown in

FIG. 6, and described in Paragraph 0077.)

As per dependent Claim 2, Yanase et al discloses:

- wherein the division pattern storing means stores plural division patterns for

  an electronic document of one kind. (Paragraph 0084: Discloses multiple

  division patterns that not only determine patterns to separate articles, but also

  patterns to separate and determine the main body text and the title of each

  article.)

As per dependent Claim 4, Yanase et al discloses:

- wherein the division pattern storing means stores a division pattern (a

  searching division pattern) so that, when discrimination has been made to the

  inputted electronic document, within a predetermined line from a line

  coincident with the division pattern (a searching division pattern), there is not

  a line coincident with another division pattern, the line coincident with the

division pattern (a searching division pattern) is defined as the division line.

(Paragraph 0084: An embodiment of a news information by electronic mail in

which a document format analysis is performed according to the

predetermined rules (Paragraph 0079-0083)) When lines of the same

character code appear consecutively, and match a predetermined rule, the

lines are regarded as separators, and thus division lines.)

As per dependent Claim 6, Yanase et al disclose:

- wherein the labeling pattern storing means stores plural labeling patterns for

  an electronic document of one kind. (Since Paragraph 0084 discloses multiple

  division patterns that not only determines separate articles, but also the main

  body text and the title of each article. Once determining the division of the

  sections, the method is able to label an individual article, the text of the

  article, and the title of the article. Paragraph 0081-0083 discloses example of

  predetermined rules used for division purposes, but also used for labeling.)

As per dependent Claim 8, Yanase et al discloses:

- wherein the labeling pattern includes the same pattern as the division pattern.

  (Paragraph 0079-0084: Paragraphs 0079-0083 disclose an example of

  predetermined rules that is determines the separation of multiple articles from

  each other, and able to locate the title, main text, and links. Not only the

  process is able to locate each of these components, these rules are also used

for labeling the component explained in Paragraph 0084 and shown in

Figures 8 and 10.)

As per dependent Claim 10, Yanase et al discloses:

- division pattern producing means for recognizing existence of plural lines

  including similar character strings in similar positions in the electronic

  document inputted to produce the division pattern and register the same in

  the division pattern storing means. (Paragraph 0084, Figs. 7-8: Paragraph

  0084 discloses the example of separating two articles from each other. It is

  able to locate and determine the multiple line separators to break down the

  text, then able to read the number of space lines of broken-down sections to

  determine the title and text by the number of lines separating from a

  subsequent section. Then the title and text is paired together and viewed as

  one article. FIG 7 shows the example used, with FIG 8 the result from the

  disclosure of Paragraph 0084.)

As per independent Claim 12, Shimada et al discloses a method:

- a document dividing step of applying one or plural division patterns defining a

  predetermined character string which can be expressed in a division line to

  the electronic document inputted to divide the electronic document to plural

  partial documents and a labeling step of applying labeling patterns provided

  with classification information pieces said classification information pieces

defining a predetermined character string which specifies classification to the

respective partial documents obtained by the division conducted in

classification to the respective partial documents obtained by the division

conducted in the document dividing step by providing the classification

information pieces to the respective partial documents.   (FIG 7-8; Paragraphs

0080, 0084: Discloses news information in an electronic mail format

containing line separators composed of characters, regarded as a separator

for separating articles from one another within. These character lines are

predetermined rules for separating. (Paragraph 0079-0080) Paragraph 0084

discloses an example using FIG 7 containing multiple character lines where

the lines are used to separate the articles from each other. In addition, other

division patterns are used to separate the title and the main body of text from

within each of the separated articles. As stated in Paragraph 0084,

predetermined character strings such as space lines specify a partial aspect

of the document if it's a title or text of that article. For example, a section

separated from an subsequent section with only one line (one predetermined

character string) is regarded as the title of the article and a section separated

from a subsequent section with a plurality of lines (another predetermined

character string) is regarded as the text of the article. Thus, FIG 8 and 10

shows the result of labeling the title and text of the article based on the

classification of the predetermined character strings in the document.)

As per dependent Claim 13, Claim 13 recites similar limitations as in Claim 4 and

is similarly rejected under Yanase et al.

As per dependent Claim 16, Claim 16 recites similar limitations as in Claim 10

and is similarly rejected under Yanase et al.

As per dependent Claim 19, Yanase et al disclose:

A recording medium in which the information partitioning program according to claim 12

has been recorded. (Paragraph 0128: Discloses various storage medium used for

recording)

Claim Rejections - 35 USC § 103

17.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

18.   Claims 3 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Yanase et al (US PGPub 2001/0025288, published 10/27/2001).

As per dependent Claim 3, Yanase et al discloses the separating of news articles

in an electronic mail format (Paragraph 0084), but fails to specifically disclose the

division pattern can be applied regardless of the kind of an electronic document.

However, in Paragraph 0076, Yanase et al discloses that the conversion of extracting

text from an article in printed matter into an electronic document with the use of OCR. In

addition, Yanase et al discloses document format is assumed during the document

format analysis (The separating of multiple articles from each other. Example disclosed

in Paragraph 0084), format conversion to the specific document format can be included

and executed. It was well-known to one of ordinary skill at the time of applicant's

invention that an electronic document, in an Adobe PDF, containing news articles could

be attracted by an OCR to be converted into a document form understandable by

Yanase et al's method enabling Yanase et al's document format analysis performed to

separated articles from each other using line separators, and be able to determine the

title and text of the article, and labeling the title and text of the article shown in FIG 8.

(Paragraph 0084)

It would have been obvious to one of ordinary skill in the art at the time of

applicant's invention to have combined Yanase et al's method with the disclosure above

since it would have provided the benefit of allowing any type of document, electronic or

printed, to have extracted useful news information to the user without accessing a

specific source each time.

As per dependent Claim 7, Claim 7 recites similar limitations as in Claim 3 and is

rejected under rationale. Furthermore, Yanase et al's method not only is able to

separate articles using character-coded line separators and able to determine the title

and text of the article, but it is able label the title and text of the article shown in FIG 8

(Paragraph 0084) applied to any inputted electronic document recognized through the

process disclosed in Claim 3.

19.   Claims 9, 11, 15, 17, 20 and 21 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Yanase et al (US PGPub 2001/0025288, published 10/27/2001) in

further view of Kobayashi et al (US PGPub 2003/0007397, filed 5/10/2002).

As per dependent Claim 9, Yanase et al discloses their method is able to

determine the inputted document is either electronic mail or printed matter, (Paragraph

0063, lines 7-11) and that the document format of news information is already

determined. (Paragraph 0073, lines 5-8) However, Yanase fails to specifically disclose

discriminate patterns for discriminating the kind of the electronic document inputted. On

the other hand, Kobayashi et al discloses the ability to determine the format of the

document by the character type of the input text data. (FIG 5; Paragraph 0106-116)

Kobayashi et al's method is able to determine if the text data is in HTML format, XML

format (Paragraph 0109), or an email message. (Paragraph 0111)

It would have been obvious to one of ordinary skill in the art at the time of

applicant's invention to have combined Yanase et al's method with Kobayashi et al's

method since Kobayashi's method would had made Yanase et al's method capable of

unitarily processing e-mails and HTML documents, and further to provide a recording

medium for use within.

As per dependent Claim 11, Yanase et al discloses receiving news by electronic

mail, a plurality of articles that include a plurality of topics distributed at one time, but

fails to specifically disclose that the electronic mail is a mail magazine. However,

Kobayashi et al discloses an extended e-mail system of mail magazines that is capable

of transmitting the same information to multiple destinations at once in which the email

contains large amount of information being advertisements and bodies of text.

It would have been obvious to one of ordinary skill in the art at the time of

applicant's invention to have combined Yanase et al's method with Kobayashi et al's

method since Kobayashi's method would had made Yanase et al's method capable of

unitarily processing e-mails and HTML documents, and further to provide a recording

medium for use within

As per dependent Claim 15, Yanase et al discloses a method:

- the document dividing step performs dividing to partial documents using the

  discriminated division patterns for document kind, and the labeling step

  provides the classification information pieces using the discriminated labeling

  patterns for the document kind. (Paragraph 0084: Discloses multiple division

  patterns that not only to determine and separate multiple articles from one

  another, but also the main body text and the title of each individual article.

  Once determining the division of the sections, the method is able to label an

  individual article, the text of the article, and the title of the article. Paragraph

  0081-0083 discloses example of predetermined rules used for division

  purposes, but also used for labeling.)

However, Yanase et al fails to specifically disclose comprising a document

kind discriminating step of discriminating the kind of the electronic document

inputted. On the other hand, Kobayashi et al discloses the ability to determine the

format of the document by the character type of the input text data. (FIG 5;

Paragraph 0106-116) Kobayashi et al's method is able to determine if the text

data is in HTML format, XML format (Paragraph 0109), or an email message.

(Paragraph 0111)

It would have been obvious to one of ordinary skill in the art at the time of

applicant's invention to have combined Yanase et al's method with Kobayashi et

al's method since Kobayashi's method would had made Yanase et al's method

capable of unitarily processing e-mails and HTML documents, and further to

provide a recording medium for use within.

As per dependent Claim 17, Claim 17 recites similar limitations as in Claim 11

and is similarly rejected under Yanase et al and Kobayashi et al.

As per independent claim 20, Claim 20 recites similar limitations as in Claim 1,

and 9 combined and is similar rejected under rationale.

As per independent claim 21, Claim 21 recites similar limitations as in Claim 9,

and 15 combined and is similar rejected under rationale.

Response to Arguments

20.   Applicant's arguments filed 11 January 2007 have been fully considered but they

are not persuasive.

21.   On pages 9-10, in regards to Claim 19 rejected under 35 U.S.C. 101, Applicant

argues the claim disclosing a recording medium is directed to a computer readable

medium; therefore, claim 19 is directed to statutory subject matter. However, the

Examiner disagrees.

Claim 19 states a recording medium, not a computer readable medium. A

recording medium and a computer readable medium is viewed as different items since a

recording medium has the ability as anything that capable of recording such as paper,

and not necessary viewed as hardware. Therefore, the claims, **themselves**, lack the

necessary physical articles or objects to constitute a machine or a manufacture within

the meaning of 35 USC 101. They are clearly not a series of steps or acts to be a

process nor are they a combination of chemical compounds to be a composition of

matter. As such, they fail to fall within a statutory. They are, at best, functional

descriptive material per se. Thus, in regards to claim 19, the claim, **as written**, appear

to be claiming "software systems" i.e. systems without hardware indication, which is

computer program per se. The claim as written do not recite any hardware indication.

22.   On pages 11-12, in regards to claims 1 and 12, Applicant argues that Yanase

fails to disclose the limitations labeling pattern storing means for storing therein plural

labeling patterns provided with classification information pieces said classification

information pieces defining a predetermined character string which specifics

classification of a respective partial document; and labeling means for applying the

labeling patterns stored in the labeling pattern storing means to the respective partial

documents obtained by the division conducted by the document dividing means,

respectively, to provide the classification information pieces. Applicant argues that the

same set of symbols are used to identify the title and text of the article and fail to specify

the classification of the respective partial document. However, the Examiner disagrees.

Yanase discloses an embodiment of the process of a document format analysis

that separates articles from each by character lines. (FIG 7-8; Paragraph 0080, 0084)

These character lines are predetermined rules for separating articles. (Paragraphs

0079-0080) In addition, other predetermined rules determine, separate, and label the

title of the article, text of the article and other information into a data structure.

(Paragraphs 0079-0083, 0087) As stated in Paragraph 0084, predetermined character

strings such as space lines specify a partial aspect of the document if it's a title or text of

that article. For example, a section separated from an subsequent section with only one

line (one predetermined character string) is regarded as the title of the article and a

section separated from a subsequent section with a plurality of lines (another

predetermined character string) is regarded as the text of the article. Thus, different

symbols are used to separate and specify/classify the text and the title of the article

wherein the title and text are extracted and stored in the article information storage unit.

Thus, FIG 8 shows the result of labeling the title and text of the article based on the

classification of the predetermined character strings in the document. FIG 10 discloses

other information retained, labeling the information retained from the document format

analysis, and stored in a data structure shown in FIG. 6, and described in Paragraph

0077 and 0087. Therefore, Yanase discloses those limitations.

23.   On pages 12-13, in regards to claim 6, Applicant argues that Yanase fails to

disclose the limitation wherein the labeling pattern storing means stores plural labeling

patterns for an electronic document of one kind. However, the Examiner disagrees.

As stated in the previous argument, Yanase disclose in Paragraph 0080-0084 of

plural labeling patterns of a section separated from an subsequent section with only one

line (one predetermined character string) is regarded as the title of the article and a

section separated from a subsequent section with a plurality of lines (another

predetermined character string) is regarded as the text of the article. Paragraph 0080

discloses of a different separator for separating articles from each other which also

identifies one article from another which is labeled after separating shown in Figs 10

and 11. Thus, Yanase discloses the limitation of claim 6.

24.   On page 13, in regards to claims 3 and 7, Applicant argues in reference to the

arguments of claims 1 and 12 and in additionally that the present invention relates to a

technology for optimally separating portions of an electronic document from an inputted

electronic document that does not include distinct structure information, such as HTML

tags or character font information. And that Yanase does not address the problems

described in the Description of Related Art as Yanase discloses news information,

which has separators between articles. However, the Examiner disagrees.

In response to applicant's argument that the references fail to show certain

features of applicant's invention, it is noted that the features upon which applicant relies

(i.e., distinct structure information, such as HTML tags or character font information;

problems described in the Description of Related Art) are not recited in the rejected

claim(s). Although the claims are interpreted in light of the specification, limitations from

the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26

USPQ2d 1057 (Fed. Cir. 1993).

Yanase discloses separating articles of news information from an e-mail or

magazines containing news information that was inputted wherein e-mails, magazines

etc are viewed as documents. Thus, Yanase disclose breaking/separating portions of an

electronic document. (e.g. Abstract, 0011)

25.   On pages 14-15, in regards to claims 20 and 21, Applicant argues that

Kobayashi fails to disclose the claim limitation document kind discriminating means for

referencing to the stored discrimination patterns to discriminate the electronic data

inputted as required by the claims. However, the Examiner disagrees.

a feature within Kobayashi et al enables the ability to determine the format of the

document by the character type of the input text data. (FIG 5; Paragraph 0106-116)

Kobayashi et al's method is able to determine if the text data is in HTML format, XML

format (Paragraph 0109), or an email message. (Paragraph 0111). Kobayaski et al

discloses a character-type determining unit that reads the inputted text stored in the

document, and able to determine the markup language or the text format of the text.

Since Kobayski is able to recognize the format through the character-type determining

unit since the unit knows what tags are in the HTML or XML format or an email, it

references to the discriminating patterns stored. Thus, Kobayaski et al is able to read

the "discriminating patterns" to determine the electronic document inputted. Therefore,

Kobayaski et al cures the deficiencies of Yanese et al.

26.   Finally, on page 15, Applicant argues that the previous Office action elies on

impermissible hindsight to either indicate that passages of the applied references

disclose the recited features of the claims or to modify the base reference as the applied

references are not directed to the claimed invention.

In response to applicant's argument that the examiner's conclusion of

obviousness is based upon improper hindsight reasoning, it must be recognized that

any judgment on obviousness is in a sense necessarily a reconstruction based upon

hindsight reasoning. But so long as it takes into account only knowledge which was

within the level of ordinary skill at the time the claimed invention was made, and does

not include knowledge gleaned only from the applicant's disclosure, such a

reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA

1971).

Conclusion

27.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to David Faber whose telephone number is 571-272-2751.

The examiner can normally be reached on M-F from 8am to 430pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Stephen Hong, can be reached on 571-272-4124. The fax phone number

for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

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you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

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